



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,879	02/15/2001	Ned M. Smith	42390P10821	4562

8791 7590 08/26/2005

BLAKELY SOKOLOFF TAYLOR & ZAFMAN  
12400 WILSHIRE BOULEVARD  
SEVENTH FLOOR  
LOS ANGELES, CA 90025-1030

EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/784,879

Applicant(s)

SMITH ET AL.

Examiner

Bradley B. Bayat

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17, 21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

This communication is in response to applicant's amendment filed June 3, 2005.

Applicant has cancelled claims 1-16, 24, 25 and amended claims 17, 21 and 23. Thus, claims 17, 21 and 23 remain pending.

### ***Response to Arguments***

Applicant's arguments filed on June 3, 2005 have been fully considered but they are not persuasive. At the request of applicant's counsel, a telephone interview was conducted on June 2, 2005 with Mr. Skabrat concerning the invention and patentability of the claims over the cited art. However, after our phone interview and careful consideration of applicant's arguments in the above referenced response, applicant's amendments to the claims fail to overcome the prior art.

At the outset, it is critical to point out that applicant has indicated in the specification and during the phone interview, that a primary difference between the instant application and the prior art is that "embodiments of the present invention support shared processes without the use of trusted third parties (specification p. 5). Furthermore, applicant declares, "[t]he invention defines a process for creating and modifying a shared business process. It identifies parties as participants wherein each party is a shared contributor or agent, with no dominant authority or hierarchy among the parties." Id. Moreover, the specification states "archive agent" which may be the same entity as the "purchase/subscribe agent" stores the electronic contract. Id. at 19. Thus, the "agent" may distribute the electronic contract to the process owners, who in turn may distribute the electronic contract to participants. Id.

Art Unit: 3621

Applicant's independent claim 17 is directed to a system for handling electronic contracts. According to one embodiment, such processing may be performed by the system in response to processor executing sequences of instructions in memory (specification pages 26-27). Such instructions are read into memory from another computer-readable medium, such as data storage device or a network controller. Id. Execution of the sequences of instructions causes processor to execute electronic contract processing according to embodiments of the present invention. Id. In an alternative embodiment, hardware circuitry is used in place of or in combination with software instructions to implement the present invention. Id. Accordingly, the present invention is not limited to any specific combination of hardware circuitry and software as disclosed and consequently carried out by the system claim of 17. Id.

In light of applicant's disclosure described above and the language of system claim 17, the examiner submits that Dan discloses the elements recited in detail in the previous rejection and as per the telephonic interview noted above. The fact that Dan does not use applicant's purchase or publish /subscribe terminology does not overcome the prior art. In fact, according to applicant's system claim and the disclosure, Dan's service contract system "provides for a self-enforcing mechanism for managing the service transactions by providing for enforcement code (or modules) to be written by the respective parties according to the rules of interaction included in the service contract (see column 6, lines 17-25)." Furthermore, an important aspect of the service contract in Dan is that "the enforcement code can be generated automatically" for incorporation within an existing application to serve as the contract enforcement component (see column 6, lines 26-37). Therefore, applicant's arguments fail because they amount to a general allegation that the claims define a patentable invention relying on applicant created terminology

Art Unit: 3621

without specifically pointing out how the language of the system claims and corresponding structures patentably distinguish them from the cited art.

In response to applicant's amendment of system claim 17 reciting "in order for the participants to be notified of at least one of the changes to the shared business process, change of authority, and security compromises," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Therefore, applicant's amended language of claim 17 not only fail to further limit the preceding structure but furthermore, lack any structure necessary to accomplish the purported function for a system claim.

Accordingly, **THIS ACTION IS MADE FINAL.**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17, 21 and 23 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

The omitted structural cooperative relationships are noted in applicant's amended purchase/subscribe element of system claim 17. Specifically, the claimed subject matter recites "a purchase/subscribe agent coupled to the archive agent and the parties to receive registrations

Art Unit: 3621

from the participants **in order for the participants to be notified of at least one of the changes to the shared business process, change of authority, and security compromises...**"

(emphasis added to note amended portions of claim 17).

The essential structural cooperative relationship of elements to accomplish the purported function as amended above in system claim 17 amounts to a gap between the necessary structural connections. While corresponding **structure** need not include all things **necessary** to enable the claimed invention to work, it must include all **structure** that actually performs the recited function. See *Cardiac Pacemakers, Inc. v. St. Jude Med, Inc.*, 296 F.3d 1106, 1119 (Fed.Cir. 2002).

Accordingly, since claims 21 and 23 depend on independent claim 17, the pending claims are all rejected under 35 U.S.C. 112, second paragraph.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The examiner has indicated amended terminology in the claimed subject matter in bold.

Claims 17, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al. (hereinafter Dan), US Patent 6,148,290.

17. (Currently amended) A system for managing a lifecycle of an electronic contract comprising:

- at least two parties to share a business process represented by the electronic contract, each of **the** parties comprising at least one participant for performing an element of the shared business process, each of the parties exchanging key

Art Unit: 3621

fingerprints associated with the electronic contract, negotiating the electronic contract, and digitally signing and verifying the electronic contract using the key fingerprints (column 6, lines 11-25; column 8, lines 44-66);

- a role certificate for presentation by a first participant of a first party to a second participant of a second party to verify, according to trust rules defined in the electronic contract. that the first participant is authorized to perform at least part of the shared business process (column 7, lines 17-36; column 7, line 48-column 8, line 43; column 8, lines 44-66);
- an archive agent coupled to the parties to store the signed and verified electronic contract (column 7, lines 24-47); and
- a purchase/subscribe agent coupled to the archive agent and the parties to receive registrations from the participants **in order for the participants to be notified of at least one of changes to the shared business process, change of authority, and security compromises** (column 6, lines 11-38; column 7, lines 38-47; figs 4-6, 9 and associated text; see columns 7-8 for details of the system process).

Dan does not explicitly disclose the step of distributing the electronic contract to the participants **according to a publish and subscribe model**. This “publish/subscribe model” is defined as facilitating “movement of the electronic documents as well as drives execution of the lifecycle itself (specification p. 6). As per applicant broad definition of the publish/subscribe model, this step is deemed to be inherent to the Dan system since a plurality of parties who jointly negotiate a service contract, and register the service contract, naturally would be able to

Art Unit: 3621

generate, publish, view or print the service contract consistent with the negotiated terms and rules of the contract and the enforcer module (column 6, lines 11-61). In other words, Dan's contract management system provides for all permitted interactions afforded to the parties, including access and distribution of the service contract via the client or service application as described in column 6, line 63-column 7, line 16.

21. (Original) As discussed above, Dan further discloses the system of claim 17, wherein the parties cross-check each other's digital signatures on the electronic contract (column 8, line 44-column 9, line 8).

23. (Original) As discussed above, Dan further discloses the system of claim 17, wherein the parties determine terms and conditions of the electronic contract and define allowable roles for participants and process elements (column 8, lines 21-43).

*Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*



***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US Patent 6,775,658 B1 to Zothner.
- USPAP 2002/0091579A1 to Yehia et al.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday - Friday 8 a.m.-6:30 p.m. and by email: [bradley.bayat@uspto.gov](mailto:bradley.bayat@uspto.gov). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached regarding urgent matters at 571-272-6712.

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Or faxed to:

(571) 273-8300 - Official communications; including After Final responses.

(571) 273-6704 - Informal/Draft communications to the examiner.

bbb

*Shia Lee S*  
PRIMARY EXAMINER